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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/040,292

10/25/2001

Frederick M. Morgan

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EXAMINER

A. MINH D

ART UNIT

PAPER NUMBER

2821

MAIL DATE

DELIVERY MODE

05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/040,292	Applicant(s) MORGAN ET AL.	
	Examiner Minh D. A	Art Unit 2821	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,14,15,17-20,23-25,27-36,38-62,74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,14,15,17-20,23-25,27-36,38-62,74 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 12, 14-15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5 of copending Application No. Pub. No:(US 2002/0163316A1). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Regarding claim 12, and claims 1-4 of the Pub. No: (US 2002/0163316A1) recites the limitations";

"at least one light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED and being positioned so as to illuminate the liquid with substantially unguided radiation, wherein the one of the pool and the spa has a range of typical liquid levels of the liquid during use, and wherein the at least one light source is adapted to be disposed below the range of typical liquid levels; and an encapsulant to protect the at least one light source from moisture".

3. Claims 14-15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-5 of copending Application No. Pub. No: US2002/0163316A1) This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Regarding claims 14-15, and claims 4-5 of the Pub. No: (US 2002/0163316A1) recites the limitations”;

“the encapsulant is in contact with at least the at least one LED and enencapsulant includes a conformal coating”.

4. Claims 20, 23-25, 27-33 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-19 of copending Application No. Pub. No: US 6, 781, 329). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Regarding claim 20, and claims 1, 7 of the Patent No: (US 6, 781, 329), recites the limitations”;

“ at least one light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED, wherein the at least one light source is adapted to generate radiation of different colors without requiring the use of a color filter”.

Regarding claim 23-25, and claims 1-14 of the Patent No: US 6, 781, 329) recites the limitations”; at least one light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED, wherein the at least one LED includes

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at least two independently controllable LEDs and at least one light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED, wherein the at least one light source includes at least two independently controllable light sources and wherein the at least two independently controllable light sources include at least two independently addressable light source”.

Regarding claims 27-32, and claims 1-19 of the Patent No. (US 6, 781, 329) recites the limitations”;

“A light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED, further comprising at least one controller coupled to the at least one light source to control radiation output by the at least one light source ”

Regarding claim 33, and claims 1-19 of the Patent No. (6, 781, 329) recites the limitations”;

“ at least one light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED, further comprising at least one controller coupled to the at least one light source to control radiation output by the at least one light source, and at least one storage device, coupled to the at least one controller, to store at least one illumination program, wherein the at least one controller is adapted to execute the at least one illumination program so as to control the radiation output by the at least one light source”.

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5. Claims 20, 23-25, 27-37 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. Pub. No: US 2005/0044617). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. Claims 20, 23-24 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of copending Application No. Pub. No:(US 2002/0153851). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented

7. Claim 20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of copending Application No. Pub. No:(US 2002/0173378). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented

8. Claims 23 and 27 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of copending Application No. Pub. No: US 2004/0212993). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 17-19, 35, 39, 42, 61 and 62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Pub No. 20020163316 in view of Long (Patent No: 4, 909, 749).

Regarding claims 17-19, 35, 39 and 42, U.S. Pub No. 20020163316 recited limitations as following: "at least one light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED, and an interface coupled to the at least one light source, the interface being adapted to engage mechanically and electrically with a conventional light socket supported by the one of the pool and the spa"

U.S. Pub No. 20020163316 does not disclose that, the conventional light socket includes a wedge type light socket.

Long (Patent No: 4, 909, 749, Long (Patent No: 4, 909, 749) discloses the conventional light socket (110) includes a wedge type (64) light socket (110); and the interface is adapted to engage mechanically and electrically with the wedge type light socket. Figures 1-13, col.4, lines 19-67 to col.8, lines 1-65.

It would have been an obvious to one of ordinary skill in the art at the time the invention was made to employ the light socket includes a wedge type light socket as that suggested by Long in the lamp circuit of U.S. Pub No. 20020163316, since it is desirable to use the wedge type socket that is well suited for intended use.

Regarding claims 61-62, U.S. Pub No. 20020163316 recited limitations as following: "at least one light source adapted to be supported by one of a pool and a spa to illuminate a liquid contained in the one of the pool and the spa, the at least one light source including at least one LED, and an interface coupled to the at least one light source, the interface being adapted to engage mechanically and electrically with a conventional light socket supported by the one of the pool and the spa"

U.S. Pub No. 20020163316 does not disclose that, the conventional light socket includes a wedge type light socket.

Long (Patent No: 4, 909, 749, Long (Patent No: 4, 909, 749) discloses the conventional light socket (110) includes a wedge type (64) light socket (110); and the interface is adapted to engage mechanically and electrically with the wedge type light socket. Figures 1-13, col.4, lines 19-67 to col.8, lines 1-65.

It would have been an obvious to one of ordinary skill in the art at the time the invention was made to employ the light socket includes a wedge type light socket as that suggested by Long in the lamp circuit of U.S. Pub No. 20020163316, since it is desirable to use the wedge type socket that is well suited for intended use.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu A whose telephone number is (571) 272-1817. The examiner can normally be reached on M-F (5:30 AM-2: 45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Owens Douglas W can be reached on (571) 272-1662. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner

Minh A

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4/28/07

Shih-Chao Chen
SHIH-CHAO CHEN
PRIMARY EXAMINER